

### **REMARKS**

After entry of this paper, claims 16-17, 19-31, and 33 will be pending and will stand rejected. Claim 32 is canceled without prejudice or disclaimer, and the subject matter thereof has been incorporated into claim 33. No new matter has been introduced.

Applicant submits that the amendments presented herein place the application in condition for allowance, or, in the alternative, in better condition for appeal. Applicant further submits that the amendments presented herein do not require further search or consideration. Applicant accordingly respectfully requests entry of the amendments presented herein.

Applicant has reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicant submits that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

### **Double Patenting Rejection**

The Examiner rejects claims 16-17 and 19-33<sup>1</sup> on the grounds of nonstatutory, obviousness-type double patenting over claims 1 and 7 of United States patent no. 7,234,225. The Examiner also provisionally rejects claims 16-17 and 19-33 on the grounds of nonstatutory, obviousness-type double patenting over claims 1-18 of United States application no. 11/819,297.

The rejection of claim 32 is moot in view of the cancellation thereof. Applicant will submit appropriate terminal disclaimers to overcome the remaining double patenting rejections upon receiving an indication of allowable subject matter.

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<sup>1</sup> The Office action indicates that claims 16-33 are rejected. In view of the previous cancellation of claim 18, Applicant believes that this is a correct statement of the rejection.

**Rejection Under 35 U.S.C. § 102**

The Examiner rejects claims 17, 19, 21-23, 25-27, and 29-33 under 35 U.S.C. § 102(b) as anticipated by United States patent no. 5,417,208 to Winkler ("Winkler"). To be anticipatory, a single prior art reference must explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). The rejection of claim 32 is moot in view of the cancellation thereof. As to the remaining claims, Applicant respectfully submits that Winkler fails to meet this standard.

Claim 33 recites, *inter alia*, that "the portion of the overmold of the catheter remaining adjacent the exposed portion of the at least one arbitrarily-shaped electrode provides a generally smooth finish to the catheter." By way of further explanation, in some embodiments of the invention, "the outer surface of the electrode is flush with the catheter's outer surface." Specification, para. [0039].

The Examiner maintains that Winkler's catheter has a "generally' smooth finish." Office action, para. 15. Specifically, the Examiner maintains that "the outer surface of the [Winkler] catheter will still be 'generally smooth,' especially since the depth of the removed portion cannot be greater than 0.02 inches ... ." Office action, para. 4. The Examiner also asserts that "the applicant admits that figure 1 [of Winkler] shows a generally smooth finish. Therefore, the applicant must also consider figure 4D to show a generally smooth finish as well, since this shows the same thing as figure 1, only in greater detail. Figure 4D and Figure 4A show the same depression. If figure 4D is 'generally smooth,' then figure 4A should be as well." *Id.*

Applicant respectfully submits that Figures 1 and 4D of Winkler do not show the same thing in varying degrees of detail. Applicant accordingly disagrees with the Examiner's conclusion that, if Figure 1 shows a "generally smooth finish," Figures 4A and 4D must show a "generally smooth finish" as well. Instead, Figures 4A and 4D show the Winkler catheter at earlier stages of manufacture than Figure 1. Specifically, Figure 4A shows the Winkler catheter after wire 45 has been exposed through hard layer 20, while Figure 4D depicts the Winkler catheter after application of a conductive ribbon 51, but prior to the introduction of the electrodes 30 that are crimped down to the

outer diameter of tubing 12, thereby providing the generally smooth finish depicted in Figure 1. *E.g.*, Winkler, 6:6-22, 7:23-39. That is, it is not until crimped electrode 30—which is *not* “exposed through and completely surrounded by” overmold, and therefore is *not* the claimed “arbitrarily-shaped electrode”—is in place that Winkler’s device possesses “a generally smooth finish.”

In sum, even assuming *arguendo* that either wire 45 or conductive elements 51 can properly be considered “arbitrarily-shaped electrode[s] overmolded by a portion of the catheter, at least a portion of the at least one arbitrarily-shaped electrode being exposed through and completely surrounded by the overmold of the catheter[.]” both of which Applicant disputes, neither wire 45 nor conductive elements 51 provide the claimed “generally smooth finish to the catheter.” Likewise, while electrodes 30 may provide the claimed “generally smooth finish,” they are not “arbitrarily-shaped electrode[s] overmolded by a portion of the catheter, at least a portion of the at least one arbitrarily-shaped electrode being exposed through and completely surrounded by the overmold of the catheter[.]”

Winkler, therefore, does not teach or suggest each and every element of, and accordingly does not anticipate, claim 33. Claims 17, 19, 21-23, 25-27, and 29-31 depend from claim 33 and are allowable for at least the same reasons. Reconsideration and withdrawal of the rejection of claims 17, 19, 21-23, 25-27, 29-31, and 33 is respectfully requested.

### **Rejections Under 35 U.S.C. § 103**

The Examiner rejects claims 16, 20, and 28 under 35 U.S.C. § 103 as obvious over Winkler. The Examiner also rejects claim 24 under 35 U.S.C. § 103 as obvious over Winkler in view of United States patent no. 5,125,913 to Quackenbush (“Quackenbush”). Applicant respectfully disagrees.

Though the prior art references need not teach or suggest each and every limitation of a claim for that claim to be obvious, Applicant contends that the differences between the rejected claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time

the invention was made. Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57527-28 (Oct. 10, 2007) (“[T]he focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and *on what such a person would have reasonably expected to have been able to do in view of that knowledge.*”) (emphasis added).

Claims 16, 20, 24, and 28 depend from claim 33. The shortcomings of Winkler with respect to claim 33 have been discussed at length above. These shortcomings are not addressed through the addition of Quackenbush. Accordingly, Applicant submits that the claimed invention is substantially different from, and therefore non-obvious over, the asserted references. Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. Should an extension of time be deemed necessary, Applicant hereby petitions therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0B-045000US/82410-0067.

Respectfully submitted,

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